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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09-978,486	10/15/2001	Yi-Jyun Lin	06618-343002	5129

20985 7590 06/03/2003

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EXAMINER

ANDRES, JANET L

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,486

Applicant(s)

LIN ET AL.

Examiner

Janet L. Andres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-14, 17 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 15, 16, 20, 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other _____ |

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RESPONSE TO AMENDMENT

1. Applicant's amendment filed 24 March 2003 is acknowledged. Claims 1-4 and 5-22 are pending and under examination in this application. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

Claim Rejections Maintained/New Grounds of Rejection

2. The rejection of claims 1-4, 6-8, 15, 16, and 21 is maintained for reasons of record in the office action of paper no. 7. These claims still encompass modulation: see claim 1(b)(3), 4(b)(3), and 21(c)(3). Incorporation of the language of, for example, 1(a)(3) into these subsections would be sufficient to overcome this rejection.

3. Claims 1 and 2 are newly rejected under 35 U.S.C. 101 as encompassing products of nature. Because the claims do not require that the antibody be isolated, they encompass antibodies that already exist in nature. Insertion of the word "isolated" in front of "antibody" in claim 1 would overcome this rejection.

4. Claim 20 is newly rejected under 35 U.S.C. 112, first paragraph, as lacking written description. This claim is drawn to an antibody against a polypeptide comprising amino acids 407-420. While Applicant has generated an antibody against the peptide consisting of amino acids 407-420 that reacts with the parent polypeptide, the peptide is only 13 amino acids in length. It does not therefore contain structures essential to or characteristic of the mth protein, such as the unique extracellular region or the transmembrane domains. A polypeptide comprising such a sequence could thus be very different from the parent polypeptide and have

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Applicant has not described the characteristics of these proteins, or of antibodies against them, and one of skill in the art would not conclude that Applicant was in possession of such proteins and antibodies. Amendment of the claim to either incorporate functional limitations, or to limit it to antibodies against the peptide consisting of amino acids 407-420, would be sufficient to overcome this rejection.

CLAIMS 1-4, 6-8, 15, 16, 20, AND 21 ARE REJECTED. CLAIMS 9-14, 17, AND 22 ARE ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to yvonne.eyler@uspto.gov.

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly

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set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.
Patent Examiner

May 28, 2003